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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,789	02/11/2004	Birgit Oppmann	DX0935KC	4562

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DNAX RESEARCH INC.
LEGAL DEPARTMENT
901 CALIFORNIA AVENUE
PALO ALTO, CA 94304

EXAMINER

HAYES, ROBERT CLINTON

ART UNIT	PAPER NUMBER
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1649

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,789

Applicant(s)

OPPMANN ET AL.

Examiner

Robert C. Hayes, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-30 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Sequence Rules

1. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 because 37 CFR 1.821 (a)(2)(c-d) states that *each sequence disclosed must appear separately in the* “Sequence Listing” and in the text of the description and *claims* whenever described. See MPEP 2422 & 2431. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. 131 and 132.

Note that failure to respond to both the requirements for sequence compliance and the restriction requirement below will be held as *nonresponsive*, and may result in *abandonment* of this application.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-2 & 4, drawn to a complex of rodent IL-B60 and CLF-1 polypeptides, classified in Class 530, subclass 350.
 - II. Claims 1-2 & 4, drawn to a complex of rodent IL-B60 and CNTF-R polypeptides, classified in Class 530, subclass 350.
 - III. Claims 1-2 & 4, drawn to a complex of human/primate IL-B60 and CLF-1 polypeptides, classified in Class 530, subclass 350.
 - IV. Claims 1-2 & 4, drawn to a complex of human/primate IL-B60 and CNTF-R polypeptides, classified in Class 530, subclass 350.

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- V. Claims 1-9, drawn to a complex of human/primate IL-B60, CLF-1 and CNTF-R polypeptides, classified in Class 530, subclass 350.
- VI. Claims 1-2, 5-6, 8-9, drawn to a complex of rodent IL-B60, CLF-1 and human/primate CNTF-R polypeptides, classified in Class 530, subclass 350.
- VII. Claims 10-14, drawn to methods of making an antibody that recognizes a complex of human/primate IL-B60 and CLF-1 polypeptides, classified in Class 530, subclass 387.1.
- VIII. Claims 15-16, drawn to methods of producing an antibody/antigen complex comprising human IL-B60, CLF-1 and CNTF-R.
- IX. Claims 17, 22-25 & 27-28, drawn to nucleic acids encoding a complex of rodent IL-B60, CLF-1 and human/primate CNTF-R polypeptides, vector, host cells, and methods of making the polypeptide components recombinantly, classified in Class 435, subclass 69.1.
- X. Claims 17-25 & 27-28, drawn to nucleic acids encoding a complex of rodent IL-B60, CLF-1 and human/primate CNTF-R polypeptides, vector, host cells, and methods of making the polypeptide components recombinantly, classified in Class 435, subclass 69.1.
- XI. Claim 26, drawn to a method of modulating physiology or development of a cell comprising contacting said cell with an agonist or antagonist of a complex comprising IL-B60 and CLF-1, or IL-B60 and CNTF-R, classified in Class 514, subclass 2.

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XII. Claims 29-30, drawn to a method of screening for a receptor that binds a complex of IL-B60 and CLF-1, or IL-B60 and CHTF-R, classified in Class 435, subclass 7.21.

3. The inventions are distinct, each from the other because of the following reasons:

Although there are no provisions under the section for "Relationship of Inventions" in M.P.E.P. § 806.05 for inventive groups that are directed to different products, restriction is deemed to be proper, because these products appear to constitute patentably distinct inventions for the following reasons:

Groups I-X are directed to products that are physically and functionally distinct involving proteins, antibodies and nucleic acids. Each of these products can be prepared by different processes, such as through chemical synthesis or isolation from natural sources using various isolation/ purification procedures. For example, the polypeptide complexes of Groups I-VI and antibodies of Group VII and the antibody/polypeptide complexes of Group VIII are fundamentally different molecules than the nucleic acid molecules of Groups IX-X, which in turn can be used to clone the proteins, detect expression of the proteins, or used as therapeutic agents in gene therapy. In contrast, the polypeptides of Groups I-VI can be used to generate the antibodies of Group VII. Although the antibodies of Group VII can be used in isolating the protein complexes of Groups I-VI & VIII, the antibodies of Group VII can be generated by immunizing animals with a small synthetic portion of the full length protein, and can be used diagnostically in other ways, such as in affinity chromatography or in immunoassays, or as therapeutic agents themselves. Nevertheless, the protein complexes of Groups I-VI can be

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utilized in making the antibodies of Group VII, but not vice versa. Additionally, neither the protein complexes of Groups I-VI nor the antibodies of Groups VII-VIII require the vectors and host cells of Group IX-X, and vice versa. Lastly, each of the individual polypeptide complexes, and nucleic acids that encode such, possess their own unique structure and function, as illustrated by each component's unique SEQ ID NO. It is pointed out that there is a proper distinction between these groups, since each product is not required in order for the other to exist. Thereby, these groups are distinct and separable for the reasons stated.

Inventions I-VI and XI-XII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the polypeptide complexes of Groups I-VI can be used to generate antibodies, etc. In contrast, methods of treating of Group XI or the methods of screening of Group XII require cells to treat, agonists, antagonists, as well as administration protocols, or alternatively require detection protocols and assays, labels, and receptors, respectively, not required for the products of Groups I-VI, and vice versa.

Because these inventions are distinct for the reasons given above, they have acquired a separate status in the art as shown by their different classification, and the lack of coextensiveness of the search and examination for each group would constitute an undue burden on the examiner to search and consider all the separable groups with their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

5. Lastly, note that *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996) addressed the issue of whether an otherwise conventional process could be patented if it were limited to making or using a nonobvious product.

In situations where product and process claims drawn to independent and distinct inventions are presented in the same application, an applicant may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. The claims to the non-elected invention will be withdrawn from further consideration. However, in the case of an elected product claim, when a product claim is found allowable, withdrawn process claims which depend from or otherwise include all the limitations of an allowable product claim will be rejoined. Withdrawn process claims not commensurate in scope with an allowable product claim will not be rejoined. In the event of rejoinder, the rejoined process claims will be fully examined for patentability. If the application containing the rejoined claims is not in condition for allowance, the subsequent Office action may be made final, or, if the application was already under final rejection, the next Office action may be an advisory action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (571) 272-0885. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on (571) 272-0867. The fax phone number for this Group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to be 'RCH' with a checkmark-like flourish at the end.

Robert C. Hayes, Ph.D.
September 29, 2006

ROBERT C. HAYES, PH.D.
PRIMARY EXAMINER